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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/631,883 | 07/31/2003 | Daniel Kahne | PUAM-0257 | 1801 |

23377 7590 03/31/2006
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PHILADELPHIA, PA 19103

EXAMINER

LUNDGREN, JEFFREY S

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1639

DATE MAILED: 03/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|---|---------------------------------|------------------------------|--|
| Advisory Action Before the Filing of an Appeal Brief | Application No. 10/631,883 | Applicant(s) KAHNE ET AL. | |
| | Examiner Jeffrey S. Lundgren | Art Unit 1639 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1, 3, 5-11, 14-23, 26-32, 35-38 and 102-116.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

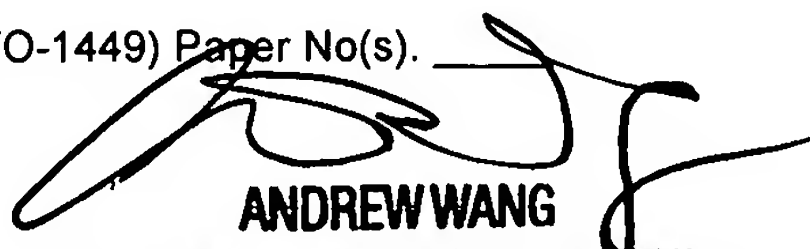
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.

13. ☒ Other: See Continuation Sheet.


ANDREW WANG
 SUPERVISORY PATENT EXAMINER
 TECHNOLOGY CENTER 1600

Continuation of 5. Applicant's reply has overcome the following rejection(s): The rejections of claims 102 and 107 as being indefinite for reciting "substituted amino group" has been overcome by Applicants' amendment.

The rejection of claims 1, 5-23 26-38 and 102-116 as being indefinite for reciting "the substituents of formula YXR" is withdrawn for the reasons in Applicants' After Final Reply.

The rejection of claims 1 and 102 as being indefinite for reciting "at least one of substituents" or two or more of the substituents" is withdrawn for the reasons in Applicants' After Final Reply.

The rejection of claims 102 for reciting "the substituents of formula XYR" for lack of antecedent basis is overcome by Applicants' amendment to the claims

The rejection of claim 1 and all claims dependent therefrom for the incorporation of new matter is withdrawn in view of Applicants' arguments in the After Final Reply.

The rejections of the claims for Obvious-type double patenting over the '238, '661, and '168 patents is withdrawn in view of Applicants filing of the terminal disclaimers.

Continuation of 13. Other: Applicants have amended the claims by changing the scope of the invention. The amendment introduces a new limitation, that requires that the YXR substituent be attached at the C-6 position of glucose, which would require a new search and considerations of patentability.

Applicants amendment also does not place the Application in better condition for allowance, as the rejection of the claims under 35 U.S.C. § 112, first paragraph, for lack of written description and lack of enablement for the full scope of the invention, are maintained. Applicants' arguments have been fully considered but are not found persuasive because they neither had possession for the full breadth of the claims, nor had fully enabled the claims glycopeptide. As set forth in the previous Office Actions, Applicants' broadly claimed compounds are hardly supported by the narrow examples of A4-modified vancomycin attached to the C-6 position of the glucose residue having at least one substituent of the formula YXR.